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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,036	12/28/2000	Veronique Ferrari	05725.0832-00	5474
22852 7590 08/24/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER VENKAT, JYOTHSNA A	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 08/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/749,036

Applicant(s)

FERRARI ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/6/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims pending in the application are  
121,122,124,127,129,131,132,137,143,144,147,153,157,158,161,166,169,170,172,177-180,183,218,219,221 and 223.

Continuation of Disposition of Claims: Claims rejected are  
121,122,124,127,129,131,132,137,143,144,147,153,157,158,161,166,169,170,172,177-180,183,218,219,221 and 223.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/6/07 has been entered.

Receipt is also acknowledged of IDS filed on 6/6/07.

### ***Information Disclosure Statement***

The foreign patents that are not in English language have been considered to the extent that it reads on the abstracts or English equivalents.

Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 are currently pending in this application and the status of the application is as follows:

### ***Response to Arguments***

Applicant's arguments with respect to claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 rejected under 103 over the combination of U.S. Patent Nos. 5,783,657, 3,148,125 and 6,214,329 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

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1. Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221 and 223 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,783, 657 ('657); 6,682,749 ('749) and 6, 214, 329 ('329).

The instant application is claiming

1. Polymer of formula I
2. Pasty fatty substance
3. Oil or non-volatile oil (claims 143-144, and 147)
4. Volatile oil (claim 153)
5. Amphilic compound (claim 172)
6. Coloring agent (claims 178-180)
7. Wax (claim 183)
8. Additives (claim 177)

The patent '657 teaches polymer claimed in the instant application (ingredient 1) having *gel consistency* and these gels are useful in personal care products where in some self-supporting consistency is desired. See the abstract; see cols. 3-4 and see col.3, line 24 where the patent teaches that these polymers are useful in eye-makeup. The eye make up products are Mascara, eye shadow and eyeliner. The patent suggests the usefulness of this polymer in the eye-make up art. *The patent at col.17, lines 25-30 teaches that this polymer can be combined with water, colorants and fillers and also teaches adding volatile solvent.* Patent '749 also teaches cosmetic compositions using silicones which function as gels (col.3, ll 29-31, col.3, ll 50 et seq.) and teaches volatile and non volatile silicone oils at col.7, ll 25-63, surfactants at col.9, ll 20-62 and

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teaches at col.11, stearyl dimethicone, and this compound belongs to pasty fatty substance (silicone waxes). Patent teaches this compound as a thickener. See also col.s 13-14 for antiperspirant compositions, and these compositions use silicone waxes. Patent '329 teaches Mascara product using specific volatile oil claimed at col.6, line 60 and at paragraph bridging cols. 8-9 the specific fillers claimed, and at col.9 pigments claimed and under example 1 teaches preservatives which are the parabens. Patent '329 teaches waxes at col.5, lines 15-37. The patent teaches the combination of waxes, coloring agents, amphilic compounds, volatile and non volatile oils and using this combination **with compounds functioning as gelling agents**.

Accordingly, it would have been obvious to one of ordinary skill in the cosmetic art at the time the invention was made to prepare compositions using the polymer of '657 and add the pasty fatty substance which has been used in compositions that function as gel along with oils, amphilic compounds, additives, pigments, and use the specific volatile solvents and waxes of '329 expecting that the compositions are useful as (cosmetics). The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of ordinary skill in the cosmetic art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and also when this polymer is combined with hydrocarbons (volatile solvent) it becomes transparent and when the composition has stearyl dimethicone it provided increased viscosity, improve aesthetics and improve the performance of the cosmetic composition. . This is prima facie case of obviousness.

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The filing date of the instant application is 12/28/00. Since there is no certified translation of the foreign priority document, all the commonly owned co-pending applications and patents are competent references.

Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 147, 153, 157-158, 161, 166, 169-170, 172, 177-180, 183, 218-219, 221, and 223 are rejected under 35 U.S.C. 103(a) as being obvious over U. S. Patents 6,402,408 ('408), 6,960,339 ('339), 7,144,582 ('582) all taken individually and combined with patents '749 and '329.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). **This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).**

All the patents teach ingredients 1 and 3-8 and patent '749 teaches ingredient 2-5 and 8 and patent '329 teaches wax and coloring agent.

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Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of any of patents and combine it with specific fatty substance, which is stearyl dimethicone into the compositions expecting the compositions to be useful to the consumer. The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and when this polymer is combined stearyl dimethicone it provided increased viscosity, improve aesthetics and improve the performance of the cosmetic composition. This is a prima facie case of obviousness.

1. Claims 121-122, 124, 127, 129, 131-132, 137, 143-144, 153, 157-158, 161,166, 169-170, 172, 177-180, 183,218-219,221, and 223 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over PGPUB US2002/0114773('773), PGPUB US2002/0122781('781), PGPUB US2002/0110036('036), PGPUB US2002/0107314('314), PGPUB US2002/0111330('330) all taken individually and combined with patents '749 and '329.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the

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application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). **This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).**

2. All the PGPUB documents teach ingredients 1 and 3-8 and patent '749 teaches ingredient 2-5 and 8 and patent '329 teaches wax and coloring agent.

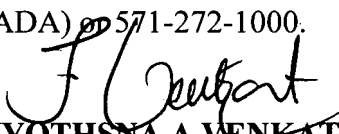
Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of any of PGPUB documents and combine it with specific pasty fatty substance, which is stearyl dimethicone into the compositions expecting the compositions to be useful to the consumer. The motivation to combine the ingredients flows logically from the art for having been used in the same cosmetic art. One of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success that the compositions which has the polymer has the structured property and when this polymer is combined stearyl dimethicone it provided increased viscosity, improve aesthetics and improve the performance of the cosmetic composition. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**JYOTHSNA A VENKAT Ph. D**  
**Primary Examiner**  
**Art Unit 1615**

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